The rejection of Claims 4 and 16 under 35 U.S.C. § 112 is respectfully traversed. Applicants have amended Claims 4 and 16. Accordingly, Applicants respectfully request that the rejection of Claims 4 and 16 under Section 112 be withdrawn.

The rejection of Claims 1-3, 5, 6-8, 11, 12-15, and 17-18 under 35 U.S.C. § 102(e) as being anticipated by Nadkarni (U.S. Patent No. 6,266,659) is respectfully traversed.

Applicants respectfully submit that Nadkarni does not anticipate the present invention. At least one of the differences between Nadkarni and the present invention is that Nadkarni does not describe nor suggest normalizing the characteristics of an individual wherein normalizing includes comparing at least one characteristic of an individual to a related pre-determined desired quality of a candidate, and assigning a value to the at least one characteristic based on the comparison.

Nadkarni describes a computer-based on-line skills/resume management system (100) that includes: (a) a relational database (102) having a plurality of fields wherein a portion of the fields are arranged in a hierarchical relationship; (b) a database population mechanism for populating the database with information, the population mechanism interfacing with a first user and prompting the first user for information for at least a portion of the fields arranged in the hierarchical relationship; (c) a query generation mechanism (201) for interfacing with a second user and prompting the second user to select a combination of the fields in the hierarchical relationship to form at least a portion of a query for searching database (102); (d) a search mechanism (203) operatively connected to database (102) for applying the query to the relational database; and (e) an output mechanism (206) for providing the second user with results of the search.

Claim 1 recites a method for determining candidates to interview that includes "providing pre-determined desired qualities for a candidate...generating a database including at least one characteristic for each individual...normalizing the characteristics, normalizing includes comparing the at least one characteristic to a related pre-determined desired quality, and

assigning a value to the at least one characteristic based on the comparison...displaying results for each individual based on the normalized characteristics...and selecting at least one candidate to interview."

Nadkarni does not describe nor suggest a method for determining candidates to interview that includes providing pre-determined desired qualities for a candidate, generating a database including at least one characteristic for each individual, normalizing the characteristics wherein normalizing includes comparing the at least one characteristic to a related pre-determined desired quality and assigning a value to the at least one characteristic based on the comparison, displaying results for each individual based on the normalized characteristics, and selecting at least one candidate to interview.

More specifically, Nadkarni does not describe nor suggest a method for determining candidates to interview that includes normalizing the characteristics wherein normalizing includes comparing at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison.

Although Nadkarni mentions at column 2, lines 42-44 that an "important aspect of the present invention is the standardization, segmentation, and organization of the candidate skill profile and resume", Nadkarni does not describe nor suggest normalizing the characteristics of an individual wherein normalizing includes comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Nadkarni.

For the reasons set forth above, Claim 1 is submitted to be patentable over Nadkarni.

Claims 2-3, and 5 depend, directly or indirectly, from independent Claim 1. When the recitations of Claims 2-3, and 5 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claims 2-3, and 5 likewise are patentable over Nadkarni.

Claim 6 recites a selection system for determining candidates to interview that includes "a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate...a processor programmed to...normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison...and display results for each candidate based on normalized characteristics."

Nadkarni does not describe nor suggest a selection system for determining candidates to interview that includes a database having at least one characteristic for each candidate and pre-determined desired qualities for a candidate, and processor programmed to normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality and assigning a value to the at least one characteristic based on the comparison, and display results for each candidate based on normalized characteristics.

More specifically, Nadkarni does not describe nor suggest a selection system for determining candidates to interview that includes a processor programmed to normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison.

Although Nadkarni mentions at column 2, lines 42-44 that an "important aspect of the present invention is the standardization, segmentation, and organization of the candidate skill profile and resume", Nadkarni does not describe nor suggest normalizing the characteristics of an individual wherein normalizing includes comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison. Accordingly, Applicants respectfully submit that Claim 6 is patentable over Nadkarni.

For the reasons set forth above, Claim 6 is submitted to be patentable over Nadkarni.

Claims 7-8, and 11 depend, directly or indirectly, from independent Claim 6. When the recitations of Claims 7-8, and 11 are considered in combination with the recitations of Claim 6, Applicants submit that dependent Claims 7-8, and 11 likewise are patentable over Nadkarni.

Claim 12 recites an apparatus for screening candidates to interview that includes "a processor comprising a memory and programmed to…generate a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate…normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison…and display results for each candidate based on normalized characteristics."

Nadkarni does not describe nor suggest an apparatus for screening candidates to interview that includes a processor comprising a memory and programmed to normalize characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison.

Although Nadkarni mentions that an "important aspect of the present invention is the standardization, segmentation, and organization of the candidate skill profile and resume", Nadkarni does not describe nor suggest normalizing the characteristics of an individual wherein normalizing includes comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison. Accordingly, Applicants respectfully submit that Claim 12 is patentable over Nadkarni.

For the reasons set forth above, Claim 12 is submitted to be patentable over Nadkarni.

Claims 13-15, and 17-18 depend, directly or indirectly, from independent Claim 12. When the recitations of Claims 13-15, and 17-18 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claims 13-15, and 17-18 likewise are patentable over Nadkarni.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 102(e) rejection of Claims 1-3, 5, 6-8, 11, 12-15, and 17-18 be withdrawn.

The rejection of Claims 4, 9-10, and 16 under 35 U.S.C. § 103(e) as being unpatentable over Nadkarni (U.S. Patent No. 6,266,659) in view of Slocum et al. (U.S. Patent No. 6,430,306) ("Slocum") is respectfully traversed.

Nadkarni is described above. Slocum describes systems and methods for employing facial recognition to create, maintain and use databases that store data records of individuals. In particular, systems and methods are disclosed that employ facial recognition to control the production of identification cards that include an image of a person's face and demographic data. The systems and methods include lensing modules adapted for identifying within a picture image the location of a person's face.

Claim 4 depends from independent Claim 1. Claim 1 recites a method for determining candidates to interview that includes "providing pre-determined desired qualities for a candidate...generating a database including at least one characteristic for each individual...normalizing the characteristics, normalizing includes comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison...displaying results for each individual based on the normalized characteristics...and selecting at least one candidate to interview."

Neither Nadkarni nor Slocum, considered alone or in combination, describe or suggest a method for determining candidates to interview that includes providing pre-determined desired qualities for a candidate, generating a database including at least one characteristic for each individual, normalizing the characteristics wherein normalizing includes comparing the at least one characteristic to a related pre-determined desired quality and assigning a value to the at least one characteristic based on the comparison, displaying results for each individual based on the normalized characteristics, and selecting at least one candidate to interview.

More specifically, neither Nadkarni nor Slocum, alone or in combination, describe or suggest a method for determining candidates to interview that includes normalizing the characteristics wherein normalizing includes comparing at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison.

Rather Nadkarni describes a computer-based on-line skills/resume management system that includes a relational database, a database population mechanism for populating the database with information, a query generation mechanism, a search mechanism, and an output mechanism. Although Nadkarni mentions standardization, segmentation, and organization of the candidate skill profile and resume, Nadkarni does not describe nor suggest normalizing the characteristics of an individual as claimed in the present invention. Slocum describes systems and methods for employing facial recognition to create, maintain and use databases that store data records of individuals. Accordingly, Applicants respectfully submit that Claim 1 is patentable over Nadkarni in view of Slocum.

When the recitations of Claim 4 are considered in combination with the recitations of Claim 1, Applicants submit that dependent Claim 4 likewise is patentable over Nadkarni in view of Slocum.

Claims 9-10 depend from independent Claim 6. Claim 6 recites a selection system for determining candidates to interview that includes "a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate...a processor programmed to...normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison...and display results for each candidate based on normalized characteristics."

Neither Nadkarni nor Slocum, considered alone or in combination, describe or suggest a selection system for determining candidates to interview that includes a processor programmed

to normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison.

Rather Nadkarni describes a computer-based on-line skills/resume management system that includes a relational database, a database population mechanism for populating the database with information, a query generation mechanism, a search mechanism, and an output mechanism; and Slocum describes systems and methods for employing facial recognition to create, maintain and use databases that store data records of individuals. Accordingly, Applicants respectfully submit that Claim 6 is patentable over Nadkarni in view of Slocum.

When the recitations of Claims 9-10 are considered in combination with the recitations of Claim 6, Applicants submit that dependent Claims 9-10 likewise are patentable over Nadkarni in view of Slocum.

Claim 16 depends from independent Claim 12. Claim 12 recites an apparatus for screening candidates to interview that includes "a processor comprising a memory and programmed to...generate a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate...normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison...and display results for each candidate based on normalized characteristics."

Neither Nadkarni nor Slocum, considered alone or in combination, describe or suggest an apparatus for screening candidates to interview that includes a processor comprising a memory and programmed to normalize characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison.

Rather Nadkarni describes a computer-based on-line skills/resume management system that includes a relational database, a database population mechanism for populating the database with information, a query generation mechanism, a search mechanism, and an output mechanism; and Slocum describes systems and methods for employing facial recognition to create, maintain and use databases that store data records of individuals. Accordingly, Applicants respectfully submit that Claim 12 is patentable over Nadkarni in view of Slocum.

When the recitations of Claim 16 are considered in combination with the recitations of Claim 12, Applicants submit that dependent Claim 16 likewise is patentable over Nadkarni in view of Slocum.

Furthermore, Applicants respectfully submit that the Section 103 rejection of the presently pending claims is not a proper rejection. As is well established, obviousness cannot be established by combining the teachings of the cited art to produce the claimed invention, absent some teaching, suggestion, or incentive supporting the combination. Neither Nadkarni nor Slocum, considered alone or in combination, describe or suggest the claimed combination. Furthermore, in contrast to the assertion within the Office Action, Applicants respectfully submit that it would not be obvious to one skilled in the art to combine Nadkarni with Slocum because there is no motivation to combine the references suggested in the art, and because the prior art teaches away from the present invention and each other. Additionally, the Examiner has not pointed to any prior art that teaches or suggests to combine the disclosures, other than Applicants' own teaching. Rather, only the conclusory statement that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the normalization method of Slocum to the database of Nadkarni" suggests combining the disclosures.

As the Federal Circuit has recognized, obviousness is not established merely by combining references having different individual elements of pending claims. Ex parte Levengood, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993). MPEP 2143.01. Rather, there
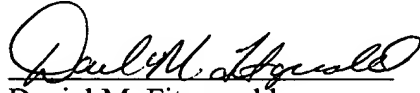
must be some suggestion, outside of Applicants' disclosure, in the prior art to combine such references, and a reasonable expectation of success must be both found in the prior art, and not based on Applicant's disclosure. In re Vaeck, 20 U.S.P.Q.2d 1436 (Fed. Cir. 1991). In the present case, neither a suggestion nor motivation to combine the prior art disclosures, nor any reasonable expectation of success has been shown.

Furthermore, it is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the cited art so that the claimed invention is rendered obvious. Specifically, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the art to deprecate the claimed invention. Further, it is impermissible to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The present Section 103 rejection appears to be based on a combination of teachings selected from multiple patents in an attempt to arrive at the claimed invention. Specifically, Nadkarni is cited for teaching generating a database including at least one characteristic for each individual, normalizing the characteristics, displaying results, and selecting at least one candidate to interview; and Slocum is cited for teaching normalizing a database by summing the records and then dividing by the number of records. Since there is no teaching nor suggestion in the cited art for the claimed combination, the Section 103 rejection appears to be based on a hindsight reconstruction in which isolated disclosures have been picked and chosen in an attempt to deprecate the present invention. Of course, such a combination is impermissible, and for this reason alone, Applicants request that the Section 103 rejection of Claims 4, 9-10, and 16 be withdrawn.

For at least the reasons set forth above, Applicants respectfully request that the 35 U.S.C. § 103(a) rejection of Claims 4, 9-10, and 16 be withdrawn.

In view of the foregoing amendments and remarks, all the claims now active in this application are believed to be in condition for allowance. Reconsideration and favorable action is respectfully solicited.

Respectfully Submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Peter J. Rock, et al.   :
                                          :   Art Unit: 2172
Serial No.: 09/687,420   :
                                          :   Examiner: Chongshan Chen
Filed: October 13, 2000   :
                                          :
For: METHODS AND APPARATUS   :
        FOR SELECTING CANDIDATES   :
        TO INTERVIEW   :

SUBMISSION OF MARKED UP CLAIMS

Hon. Commissioner for Patents
Washington, D.C. 20231

Submitted herewith are marked up Claims in accordance with 37 C.F.R. 1.121(c)(1)(ii).

IN THE CLAIMS

1. (once amended) A method for determining candidates to interview, said method comprising the steps of:

providing pre-determined desired qualities for a candidate;

generating a database including at least one characteristic for each individual;

normalizing the characteristics, normalizing includes comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison;

displaying results for each individual based on the normalized characteristics; and

selecting at least one candidate to interview.

2. (once amended) A method in accordance with Claim 1 wherein the step of providing pre-determined desired qualities for a candidate further comprises the step of storing the pre-determined

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desired qualities for a candidate within the database, the desired qualities include [the database includes] at least one of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills[, said method further comprising the step of gathering the information for the database].

4. (once amended) A method in accordance with Claim 1 wherein said step of normalizing the characteristics [ranking each individual] further comprises the steps of:

summing the normalized characteristics of each candidate; and

dividing the sum total of the normalized characteristics by a pre-determined value representing a total amount possible.

6. (once amended) A selection system for determining candidates to interview, said system comprising:

a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate;

a processor programmed to:

normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison; and

display results for each candidate based on normalized characteristics.

7. (once amended) A selection system in accordance with Claim 6 wherein said [database] pre-determined desired qualities comprise[s] at least one of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills.

12. (once amended) Apparatus for screening candidates to interview, said apparatus comprising:

a processor comprising a memory and programmed to:

generate a database comprising at least one characteristic for each candidate, and pre-determined desired qualities for a candidate;

normalize the characteristics by comparing the at least one characteristic to a related pre-determined desired quality, and assigning a value to the at least one characteristic based on the comparison; and

display results for each candidate based on normalized characteristics.
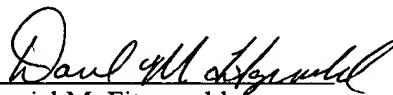
13. (once amended) Apparatus in accordance with Claim 12 wherein said [database] pre-determined desired qualities comprise[s] at least one of analytical ability, self-confidence, initiative, change orientation, and interpersonal skills.

16. (once amended) Apparatus in accordance with Claim 12 wherein [to rank each candidate,] said processor is further programmed to rank each candidate by:

[sum] summing the normalized characteristics of each candidate; and

[divide] dividing the sum total of the normalized characteristics by an amount representing a pre-determined possible total.

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